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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,739

11/13/2003

Indran Naick

AUS920030777US1(4016)

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08/13/2007

IBM CORPORATION (JSS)

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EXAMINER

BIAGINI, CHRISTOPHER D

ART UNIT

PAPER NUMBER

2142

MAIL DATE

DELIVERY MODE

08/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,739

Applicant(s)

NAICK ET AL.

Examiner

Christopher D. Biagini

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Misnumbered Claims

1. The claims as submitted are misnumbered. Two claims are labeled as claim 10, and the claims which appear to be dependent on the first "claim 10" are written as depending from claim 9. For the purposes of this examination, claims will be referenced as if they were numbered properly; that is, the second "claim 10" will be referred to as "claim 11," the next claim as "claim 12," and so on. See the attached marked-up copy. Additionally, claims 11-17 will be treated as if they were dependent on claim 10, and claims 19-23 will be treated as if they were dependent on claim 18, as this appears to be Applicant's intent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4-6, 9-11, 14, 17-19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohler (US Patent No. 6,192,396).

4. Regarding claim 1, Kohler shows a method for employing private content in an email message for recipients, the method comprising:

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- a. identifying an instance of the private content in the email message (comprising selecting a portion of the message: see col. 10, line 65 to col. 11, line 1);
 - b. associating the instance with a recipient of the recipients (step S1104: see col. 10, lines 53-61); and
 - c. generating emails for the recipients, wherein the emails are redacted to display the email message with the instance when routed to the recipient and to exclude the instance when routed to another recipient of the recipients (step S1114: see col. 11, lines 30-38).
5. Claims 10 and 18 correspond to claim 1 and are rejected for the same reasons.
6. Regarding claims 2, 11, and 19, Kohler shows the limitations of claims 1, 10, and 18 as applied above and further shows transmitting the emails to the recipients (step S1115: see Fig. 11) and a messaging gateway (server 6).
7. Regarding claims 4 and 21, Kohler shows the limitations of claim 1 and 18 as applied above and further shows wherein identifying the instance comprises identifying the instance as a highlighted portion of text in response to a command from a user (see col. 6, lines 21-38 and col. 6, line 62 to col. 7, line 3).

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8. Regarding claims 5, 14, and 22, Kohler shows the limitations of claims 1, 10, and 18 as applied above and further shows wherein associating the instance comprises interacting with a user to associate the recipient with the instance (see col. 6, line 62 to col. 7, line 3).

9. Regarding claim 6, Kohler shows the limitations of claim 5 as applied above and further shows wherein interacting with the user comprises prompting the user to select the recipient from the recipients.

10. Regarding claims 9 and 17, Kohler shows the limitations of claims 1 and 10 as applied above, and further shows wherein generating emails comprises removing the instance from the email message (see col. 11, lines 36-38).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler (US Patent No. 6,192,396) in view of Drexler (US PG PUB 2002/0046248).

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13. Kohler shows the limitations of claims 1, 10, and 18 as applied above but does not show identifying a mark adjacent to the instance, wherein the mark is incorporated into the email message by a user and is indicative of a bounding edge of the instance.

14. Drexler shows identifying a mark (comprising a "delimiter") adjacent to an instance of content, wherein the mark is incorporated into the email message by a user (see [0066]) and is indicative of a bounding edge of the instance (see Fig. 10 and [0061]).

15. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kohler with the mark identification taught by Drexler in order to provide a way to separate instances of content.

16. Claims 7, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler (US Patent No. 6,192,396) in view of Altavilla et al. (US PG PUB 2002/0194280, hereinafter "Altavilla").

17. Regarding claim 7, Kohler shows the limitations of claim 5 as applied above, but does not show wherein interacting with the user comprises prompting the user to select the recipient from an address book.

18. Altavilla shows prompting a user to select a recipient from an address book (comprising address list 16: see [0021]).

19. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kohler to prompt the user to select a recipient from an

address book as taught by Altavilla in order to allow the user to indicate recipients without having to type their addresses manually.

20. Regarding claim 13, Kohler shows the limitations of claim 10 as applied above, but does not show wherein the content identifier is configured to parse a table, wherein the table identifies a location of the instance in the email message.

21. Altavilla shows parsing a table, wherein the table identifies a location of an instance of content in an email message (the table comprising a set of tags attached to recipients: see Fig. 3 and [0025]).

22. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kohler to use a table as taught by Altavilla in order to associate recipients with appropriate instances of content.

23. Regarding claim 15, Kohler shows the limitations of claim 10 as applied above, but does not show wherein the content associator is configured to generate an index associating the first recipient with a location of an instance in the email message.

24. Altavilla shows generating an index associating a recipient with an instance of content in an email message (see Fig. 3 and [0025]).

25. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kohler to use an index as taught by Altavilla in order to associate recipients with appropriate instances of content.

26. Claims 8, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler (US Patent No. 6,192,396) in view of Rafal et al. (US PGPUB 2002/0002586, hereinafter "Rafal").

27. Regarding claims 8, 16, and 23, Kohler shows the limitations of claims 1, 10, and 18 as applied above, and further shows displaying the instance in response to routing the email to the recipient (see col. 10, lines 6-14).

28. Kohler does not show using hypertext markup language code to display the instance.

29. Rafal shows using hypertext markup language code to display email content (see [0037]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kohler with the HTML code taught by Rafal in order to provide for text formatting in the email.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on M-R 7:30-5, 7:30-4 alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D. Biagini

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ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER